

**REMARKS**

**I. CLAIM STATUS**

Claims 20-38 are currently pending. No amendments are made herein.

**II. REJECTIONS UNDER 35 U.S.C. § 103(a)**

A. The Examiner rejects claims 20-29, 33, and 35-37 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,225,749 to Pierre et al. ("Pierre"), in view of WO 99/33070 to Belli et al. ("Belli"), and further in view of U.S. Patent Application Publication No. 2006/0051499 to Balconi et al. ("Balconi") for the reasons disclosed at pages 2-6 of the January 17, 2008, Office Action.

The Examiner's reliance on Balconi as prior art is misplaced. For art to be relied upon under 35 U.S.C. § 103(a) as the basis for an obviousness rejection, the art must first qualify as prior art under the definition of 35 U.S.C. § 102. Applicants submit that Balconi is not prior art to the present application and, thus, the rejection is improper.

Applicants' application is a national phase application based on PCT/EP03/14782, filed December 18, 2003, and claims priority of International Application No. PCT/EP03/08194, filed July 25, 2003. Balconi, which published March 9, 2006, is also a national phase application based on PCT/IT02/00824, filed December 23, 2002. Accordingly, Balconi is only available as possible § 102(e) prior art.

While Balconi qualifies as § 102(e) prior art, it is not available as prior art for an obviousness rejection pursuant to 35 U.S.C. § 103(c).

35 U.S.C. § 103(c) states that subject matter that qualifies as prior art only under 35 U.S.C. §§ 102(e), (f), and/or (g) is disqualified as prior art against the claimed

invention if that “subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.” Common ownership may be established by a conspicuous statement indicating that the claimed invention and a § 102(e) reference were, at the time the invention was made, commonly owned or subject to an obligation of assignment to the same person. See M.P.E.P. § 706.02(I)(2)(II).

With this in mind, Applicants submit that Balconi is not available as prior art, because the present invention and Balconi were, at the time the invention was made, subject to an obligation of assignment to the same person, *i.e.*, Pirelli & C. S.p.A. See M.P.E.P. § 706.02(I)(2)(II). Both are now assigned to Prysmian Cavi e Sistemi Energia S.r.L.

Because Balconi is not available as prior art in a § 103(a) rejection of the instant application, Applicants respectfully submit that the Examiner cannot rely upon it to support the pending § 103 rejection. Accordingly, the rejection is improper and the Applicants respectfully request that the Examiner withdraw this rejection.

B. The Examiner rejects claims 30, 33, and 34 under 35 U.S.C. § 103(a) as being unpatentable over Pierre, Belli, and Balconi as applied to claim 20 above, and further in view of U.S. Patent No. 6,501,027 to Belli et al. (“the ’027 patent”) for the reasons disclosed at page 6 of the January 17, 2008, Office Action.

Applicants respectfully traverse for at least the following reason.

As set forth above, Balconi is not available as prior art in a § 103(a) rejection of the instant application. Since the rejection as applied to claim 20 was based improperly

upon Balconi, Applicants respectfully submit that this rejection of claims 30, 33, and 34 is also improper and should be withdrawn.

C. The Examiner rejects claims 31 and 32 under 35 U.S.C. § 103(a) as being unpatentable over Pierre, Belli, and Balconi as applied to claim 29 above, and further in view of WO 03/088274 to Belli et al. ("WO '274") for the reasons disclosed at pages 6-7 of the January 17, 2008, Office Action.

Applicants respectfully traverse for at least the following reason.

As set forth above, Balconi is not available as prior art in a § 103(a) rejection of the instant application. Since the rejection as applied to claim 29 was based improperly upon Balconi, Applicants respectfully submit that this rejection of claims 31 and 32 is also improper and should be withdrawn.

D. The Examiner rejects claim 38 under 35 U.S.C. § 103(a) as being unpatentable over Pierre, Belli, and Balconi as applied to claim 20 above, and further in view of U.S. Patent Application Publication No. 2004/0091631 to Belli et al. ("the '631 application") for the reasons disclosed at pages 7-8 of the January 17, 2008, Office Action.

Applicants respectfully traverse for at least the following reason.

As set forth above, Balconi is not available as prior art in a § 103(a) rejection of the instant application. Since the rejection as applied to claim 20 was based improperly upon Balconi, Applicants respectfully submit that this rejection of claim 38 is also improper and should be withdrawn.

Furthermore, this rejection is improper because the '631 application is also not available as prior art in a § 103(a) rejection of the instant application. For art to be relied upon under 35 U.S.C. § 103 as the basis for an obviousness rejection, the art must first qualify as prior art under the definition of 35 U.S.C. § 102. Here, the '631 application qualifies as § 102(e) prior art; however, it is not available as prior art for an obviousness rejection pursuant to 35 U.S.C. § 103(c).

The current application has an effective U.S. filing date of July 25, 2003. The '631 application was published after but filed before July 25, 2003. Accordingly, the '631 application is only available as prior art under 35 U.S.C. § 102(e).

With this in mind, Applicants submit that the '631 application is not available as prior art for an obviousness rejection pursuant to 35 U.S.C. § 103(c), because the present invention and the '631 application were, at the time the invention was made, subject to an obligation of assignment to the same person, *i.e.*, Pirelli & C. S.p.A. See M.P.E.P. § 706.02(I)(2)(II). Both are now assigned to Prysmian Cavi e Sistemi Energia S.r.L.

Because the '631 application is not available as prior art in a § 103(a) rejection of the instant application, Applicants respectfully submit that this rejection of claim 38 is improper for this additional reason and should be withdrawn.

### **Conclusion**

In view of the foregoing remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

If the Examiner believes a telephone conference could be useful in resolving any outstanding issues, the Examiner is respectfully invited to contact Applicants' undersigned counsel at (202) 408-4152.

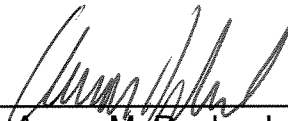
Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: May 15, 2008

By: \_\_\_\_\_

  
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